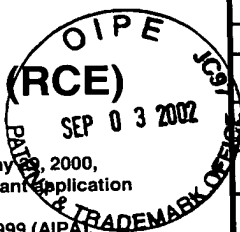


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# REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000, provides for continued examination of an utility or plant application filed on or after June 8, 1995.  
See The American Inventors Protection Act of 1999 (AIPA).



Application Number	09/438,358
Filing Date	November 12, 1999
First Named Inventor	GERARD
Group Art Unit	1636
Examiner Name	Leffers, Jr., G.
Attorney Docket Number	0942.4640001/RWE/BJD

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

**NOTE:** 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53 (d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE practice.

## 1. Submission required under 37 C.F.R. § 1.114

- a. ☒ Previously submitted
- i. ☐ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on \_\_\_\_\_  
(Any unentered amendment(s) referred to above will be entered).
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_
- iii. ☒ Other -- Consider the Third Suppl. Information Disclosure Statement previously filed on August 1, 2002.
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☒ Fourth Supplemental Information Disclosure Statement (IDS)
- iv. ☐ Other \_\_\_\_\_

## 2. Miscellaneous

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(i) required)
- b. ☒ Other Petition for Extension of Time; Fee Transmittal Form (Form PTO/SB/17)
3. Fees The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed.
- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Deposit Account No. 19-0036
- i. ☒ RCE fee required under 37 C.F.R. § 1.17(e)
- ii. ☒ Extension of time fee (37 C.F.R. §§ 1.136 and 1.17)
- iii. ☐ Other \_\_\_\_\_
- b. ☐ Check in the amount of \$ \_\_\_\_\_ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	BRIAN J. DEL BUONO STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.	Registration No. (Attorney/Agent)	42,473
Signature		Date	September 3, 2002

## CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, Box RCE, Washington, DC 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on:

Name(Print/Type)		Date	
Signature		Date	

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND Fees and Completed Forms to the following address: Commissioner for Patents, Box RCE, Washington, DC 20231.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

GERARD *et al.*

Appl. No. 09/438,358

Filed: November 12, 1999

For: **Compositions and Methods for  
Recombinational Cloning of  
Nucleic Acid Molecules**

Confirmation No.: 9194

Art Unit: 1636

Examiner: Leffers Jr., G.

Atty. Docket: 0942.4640001/RWE/BJD

#24/B  
Zeta  
9-10-02

**Amendment and Reply Under 37 C.F.R. § 1.111**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Filed concurrently herewith is a Request for Continued Examination (RCE) in the above-referenced matter. Applicants note that a RCE was filed in the present matter on August 1, 2002, along with a Third Supplemental Information Disclosure Statement. However, that RCE was considered improper as indicated by a Notice of Improper Request For Continued Examination (Form PTO-2051), for allegedly not including a submission as required under 37 C.F.R. § 1.114.

Therefore, in reply to the Office Action issued in this matter on **October 1, 2001** (PTO Prosecution File Wrapper Paper No. 13), Applicants submit the following amendments and remarks. It is respectfully believed that entry and consideration of these amendments and remarks is proper under 37 C.F.R. § 1.114, since this submission is being filed prior to payment of the issue fee, abandonment of the application, or filing of a Notice

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01 FC:104 280.00 CH  
02 FC:103 1368.00 CH

of Appeal to the U.S. Court of Appeals for the Federal Circuit. The amendments are provided in the following format:

- (A) A clean version of each replacement paragraph/section/claim along with clear instructions for entry;
- (B) Starting on a separate page, appropriate remarks and arguments.  
37 C.F.R. § 1.116; and
- (C) Starting on a separate page, a marked-up version entitled: "Version with markings to show changes made."

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 19-0036.

### *Amendments*

#### *In the Claims:*

✓

(a) Please cancel claims 77-80, without prejudice to or disclaimer of the subject matter contained therein. Applicants reserve the right to pursue the subject matter of these claims in one or more continuing and/or divisional applications.

(b) Please amend claims 14, 15, 18, 19, 31 and 40 as follows:

# FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision

TOTAL AMOUNT OF PAYMENT

(\$) 2,168.00

## Complete if Known

Application Number	09/438,358
Filing Date	Nov. 12, 1999
First Named Inventor	GERARD
Examiner Name	Leffers, Jr., G.
Group Art Unit	1636
Attorney Docket No.	0942.4640001/RWE/BJD

## METHOD OF PAYMENT (check one)

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to:

Deposit Account Number	19-0036
Deposit Account Name	Sterne, Kessler, Goldstein & Fox P.L.L.C.

- ☒ Charge Any Additional Fee Required Under 37 CFR §§ 1.16 and 1.17

☐ Applicant claims small entity status See 37 CFR 1.27

2. ☒ Payment Enclosed:

☒ Check ☐ Credit card ☐ Money Order ☒ Other\*

\*Charge any deficiencies or credit any overpayments in the fees or fee calculations of Parts 1, 2 and 3 below to Deposit Account No. 19-0036.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1) (\$)

### 2. EXTRA CLAIM FEES

	Extra	Fee from below	Fee Paid
Total Claims	138 - 62** = 76	X 18.00	= 1368.00
Indep. Claims	4 - 4** = 0	X 0	= 00.00
Multiple Dependent		280.00	= 280.00

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim
108	84	209	42	**Reissue independent claims over original patent
110	18	210	9	Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

\*\* or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description
105	130	205	65	Surcharge - late filing fee or oath
127	50	227	25	Surcharge - late provisional filing fee or cover sheet
139	130	139	130	Non-English specification
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination
112	920*	112	920*	Requesting publication of SIR prior to Examiner action
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action
115	110	215	55	Extension for reply within first month
116	400	216	200	Extension for reply within second month
117	920	217	460	Extension for reply within third month
118	1,440	218	720	Extension for reply within fourth month
128	1,960	228	980	Extension for reply within fifth month
119	320	219	160	Notice of Appeal
120	320	220	160	Filing a brief in support of an appeal
121	280	221	140	Request for oral hearing
138	1,510	138	1,510	Petition to institute a public use proceeding
140	110	240	55	Petition to revive - unavoidable
141	1,280	241	640	Petition to revive - unintentional
142	1,280	242	640	Utility issue fee (or reissue)
143	460	243	230	Design issue fee
144	620	244	310	Plant issue fee
122	130	122	130	Petitions to the Commissioner
123	130	123	130	Petitions related to provisional applications
126	180	126	180	Submission of Information Disclosure Stmt
581	40	481	40	Recording each patent assignment per property (times number of properties)
146	740	246	370	Filing a submission after final rejection (37 CFR 1.129(a))
149	740	249	370	For each additional invention to be examined (37 CFR 1.129(b))
179	740	279	370	Request for Continued Examination (RCE)
169	900	169	900	Request for expedited examination of a design application

Other fee (specify) : Fee difference between 2 and 3 month extension of time

Other fee (specify) :

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 520.00

## SUBMITTED BY

Name (Print/Type)	Brian J. Del Buono	Registration No. (Attorney/Agent)	42,473	Telephone	202-371-2600
Signature				Date	Sept. 3, 2002

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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